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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,760	01/04/2002	Anthony A. Sauve	96700/725	6299
	7590 02/06/2004		EXAMINER MCINTOSH III, TRAVISS C	
Craig J. Arnold, Esq. Amster, Rothstein & Ebenstein 90 Park Avenue New York, NY 10016			ART UNIT 1623	PAPER NUMBER

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/038,760		SAUVE ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Traviss C McIntosh		1623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on amendment filed 11/7/2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 6-9, 12, 13, 16, 17 and 20-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10, 11, 14, 15, 18, 19 and 30-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

The Amendment filed November 7, 2003 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claims 1 and 3 have been amended.

Receipt of the declaration is acknowledged.

Remarks drawn to rejections of Office Action mailed August 7, 2003 include:

112 2<sup>nd</sup> paragraph rejections: which have been overcome by applicant's amendments and have been withdrawn.

102(a) rejection to Sauve et al.: which has been overcome by applicant's declaration and has been withdrawn.

102(a) rejection over Von Borstel et al.: which has been maintained for reasons of record.

An action on the merits of claims 1-5, 10-11, 14-15, 18-19, and 30-37 is contained herein below.

The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1-5, 10-11, 14-15, 18-19, and 30-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a *new matter* rejection.

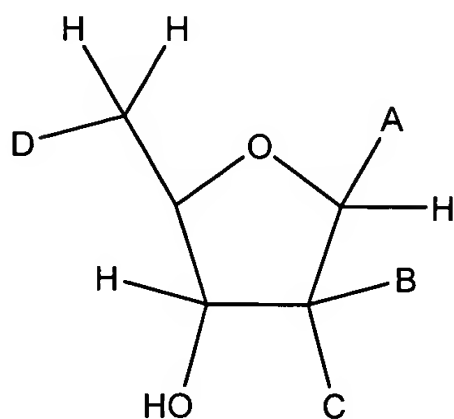
In the amendment filed by applicants on November 7, 2003, applicants have amended claims 1 and 3 to “carve out” the compound which was cited in the 102(a) rejection to Von Borstel et al., of the office action dated August 7, 2003. Applicants do not have support for the claims as amended, specifically for “compounds in which A is not a pyrimidyl or substituted pyrimidyl group”. The original disclosure does not provide any guidance for indicating that the compound must contain moieties only the recited groups other than pyrimidyl or substituted pyrimidyl groups on the A position of the compound. The changing of the scope of a claim, either by broadening or narrowing, can be construed as new matter as either is capable of changing the scope of what is claimed, and the narrower or broader group must be supported in its entirety by the specification as originally filed. As set forth supra, the original disclosure does not have support for the compound as presently claimed. Applicant is required to cancel the portion of the claims which states that A is “not a pyrimidyl or substituted pyrimidyl group”.

It is noted that a rejection of the claims is reviewable by the Board of Patent Appeals and Interferences.

***Claim Rejections - 35 USC § 102***

The rejection of claims 1-3, 10-11, 14-15, 18, 30-33, and 36 under 35 U.S.C. 102(a) as being anticipated by Von Borstel et al. (US Patent 6,103,701) is maintained for reasons of record.

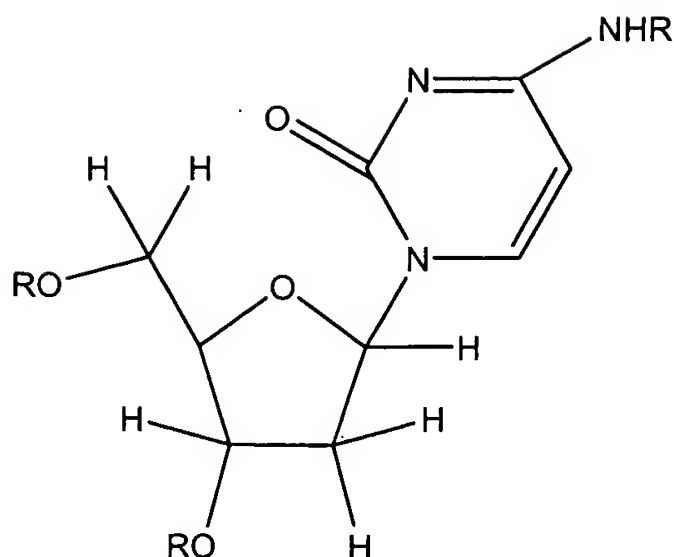
Claims 1 and 2 of the instant application are drawn to the compound of the formula:



wherein B and C are optionally H or halogen, D is optionally a phosphoryl group, and A is a N-linked heterocyclic group. Claim 3 limits A to optionally a substituted pyrimidyl group. Claims 10-11, and 30-32 limit B and C to either of both are H or one is H and the other is halogen, amino, or thiol group. Claims 14, 15, and 33 limit D to a primary alcohol or H. Claims 18 and 36 are drawn to a composition comprising the compounds of claims 1 and 3 and a carrier.

Von Borstel et al. discloses a compound in column 6, formula III, represented by the structure:

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wherein R is disclosed as being H or an acyl radical. The moiety at the A position of the instantly claimed compound is seen to be a substituted pyrimidinyl group. Von Borstel et al. show the compounds to be effective in compositions when combined with pharmaceutically acceptable carriers (column 22, lines 28-38). The structure and compositions of Von Borstel et al. are seen to anticipate the structures and compositions of claims 1-3, 10-11, 14-15, 18, 30-33, and 33 of the instant application.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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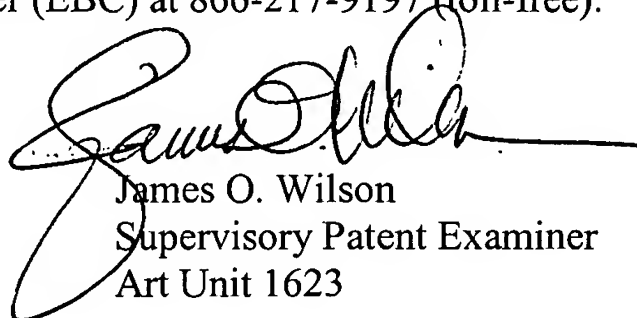
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C McIntosh whose telephone number is 703-308-9479. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Traviss C. McIntosh III  
February 2, 2004



James O. Wilson  
Supervisory Patent Examiner  
Art Unit 1623